

**REMARKS**

In response to the Office Action dated February 8, 2007, Applicants respectfully request reconsideration based on the above claim amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance. Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-4, 6-12, 14-28, and 30-33 were pending in the application, of which Claims 1, 10, 18, and 26 are independent. In the Office Action, Claims 1-4, 6-12, 14-28, and 30-33 were rejected under 35 U.S.C. §103(a). Following this response, Claims 1-4, 6-12, 14-28, and 30-33 remain in this application. Applicants hereby address the Examiner's rejections in turn.

I. Interview Summary

Applicants wish to thank Examiner Daniel for the courtesy of a telephone interview on May 8, 2007. During the interview Applicants expressed their desire to further prosecution and discussed the removal of U.S. Pat. No. 6,694, 004 ("Knoerle") under the provisions of 35 U.S.C. § 103(c). No agreement was reached regarding patentability.

II. Rejection of Claims 1-4, 6-12, 14-28, and 30-33 Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1-4, 6-12, 14-28 and 30-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,963,864 ("O'Neil") in view of U.S. Pat. No. 6,694, 004 ("Knoerle"). Claims 1, 10, 18, and 26 have been

amended, and Applicants respectfully submit that the amendments overcome this rejection and add no new matter.

Amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "determining when the associated wireless terminal has a voice messaging system" and "when the wireless terminal has the voice messaging system, the voice messaging system will not answer before the wired terminal begins ringing." Amended Claims 10, 18, and 26 each includes a similar recitation. Support for these amendments can be found in the specification at least on page 5, lines 11-14.

Consistent with embodiments of the invention, attempts to reach a subscriber's wireless unit are only made when the wireless unit is available. (See specification, page 5, lines 11-12.) As a result, in situations where the subscriber's wireless unit has a voice messaging system, the voice messaging system will not answer before a landline unit (e.g. wired terminal) rings. (See specification, page 5, lines 12-14.)

In contrast, O'Neil at least does not disclose the aforementioned recitation. For example, O'Neil discloses providing a telecommunication extension service to a subscriber with at least a first unit having a first number and a second unit having a second number. (See Abstract, lines 1-4.) In O'Neil, upon receipt of a communication directed to the number associated with the one of the units, ringing is provided to both units and a party may answer either unit, or both units may be answered. (See Abstract, lines 4-7.) If one of O'Neil's units is answered, then the other unit is provided with ringing for a predetermined number of rings or for a preselected amount of time and if the other unit is answered, then the communication is connected in a conference

call to the other unit, whereby the communication is connected to both units. (See Abstract, lines 7-12.) In *O'Neil*, the when the wireless terminal has the voice messaging system, the voice messaging system not answering before the wired terminal begins ringing does not happen, because in *O'Neil*, communication is connected to both units to form the conference call. Consequently, *O'Neil* does not disclose the voice messaging system not answering before the wired terminal begins ringing.

Furthermore, *Knoerle* does not overcome *O'Neil*'s deficiencies. *Knoerle* discloses simultaneous ringing a plurality of customer premises equipment. (See Abstract, lines 1-2.) In *Knoerle*, a centralized database of subscriber information and a service node is utilized to make multiple outbound calls from the service node to multiple telephone lines assigned to a subscriber. (See Abstract, lines 3-6.) Inbound calls to the subscriber's primary wireline are intercepted and a simultaneous ringing service is implemented. (See Abstract, lines 7-10.) Consequently, because inbound calls cause a simultaneous ringing service to be implemented for inbound calls, *Knoerle* does not disclose, when the wireless terminal has the voice messaging system, the voice messaging system not answering before the wired terminal begins ringing. This is because *Knoerle* discloses simultaneous ringing. Consequently, *Knoerle* does not disclose the voice messaging system not answering before the wired terminal begins ringing.

Combining *O'Neil* with *Knoerle* would not have led to the claimed invention because *O'Neil* and *Knoerle*, either individually or in combination, at least does not disclose "determining when the associated wireless terminal has a voice messaging system" and "when the wireless terminal has the voice messaging system, the voice

messaging system will not answer before the wired terminal begins ringing," as recited by amended Claim 1. Amended Claims 10, 18, and 26 each includes a similar recitation. Accordingly, independent Claims 1, 10, 18, and 26 each patentably distinguishes the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claims 1, 10, 18, and 26.

Dependent Claims 2-4, 6-9, 11-12, 14-17, 19-25, 27-28, and 30-33 are also allowable at least for the reasons described above regarding independent Claims 1, 10, 18, and 26, and by virtue of their respective dependencies upon independent Claims 1, 10, 18, and 26. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 2-4, 6-9, 11-12, 14-17, 19-25, 27-28, and 30-33.

Moreover, the Examiner states that subject matter disclosed in *Knoerle's* background section is an admission and may not be removed under 35 U.S.C. § 103(c). (See Office Action page 24, lines 11-18.) *Knoerle* was filed on December 28, 2000 and did not publish until *Knoerle* issued on February 17, 2004. Applicants' application was filed on June 28, 2001 which clearly falls between *Knoerle's* filing date and publication date. Therefore, *Knoerle* is only available under 35 U.S.C. §102(e). Regarding the Examiner's statement that an alleged admission in *Knoerle* cannot be removed under 35 U.S.C. § 103(c), Applicants respectfully disagree. The Court in *In re Fout* held that under 35 U.S.C. § 103(c), an Applicant's admission that subject matter (*Knoerle's* background) was developed prior to Applicant's invention would not make the subject matter prior art to applicant if the subject matter qualifies as prior art under 35 U.S.C. § 102(e), (f), or (g), and if the subject matter and the claimed invention were commonly owned at the time the invention was made. (See *In re Fout*, 675 F.2d 297, 213 USPQ

532 (CCPA 1982).) Moreover, it was held that only if the subject matter and invention were not commonly owned, an admission that the subject matter is prior art would be usable under 35 U.S.C. 103. Consequently, because *Knoerle* is only available under 35 U.S.C. § 102(e) and was commonly owned by Bellsouth Intellectual Property Corporation at the time the invention was made, any admission that may appear in *Knoerle* are not prior art and therefore cannot be used to reject Applicants application under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully submit that *Knoerle* removable under 35 U.S.C. § 103(c).

III. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 13-2725.

Respectfully submitted,  
MERCHANT & GOULD P.C.

P.O. Box 2903  
Minneapolis, MN 55402-0903  
404.954.5066

Date: May 8, 2007

DKS:ARL:mdc

/s/ D. Kent Stier/

---

D. Kent Stier  
Reg. No. 50,640

39262  
MAILED TELEGRAMS ONLY